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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,545

01/23/2006

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HM1522927APCT

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EXAMINER

PAGONAKIS, ANNA

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

05/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



<b>Office Action Summary</b>	<b>Application No.</b> 10/565,545	<b>Applicant(s)</b> MARQUAIS-BIENEWALD ET AL.	
	<b>Examiner</b> ANNA PAGONAKIS	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-27; 29-31 is/are pending in the application.
- 4a) Of the above claim(s) 25-27; 28-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-24, 29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

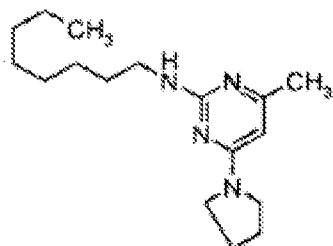
### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5 sheets; 5/30/2006</u> .                                     | 6) <input type="checkbox"/> Other: _____                          |



### DETAILED ACTION

Applicant's election of the below compound:



in the reply filed on 2/11/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

This application is the national stage entry of PCT/EP04/51516, filed 07/16/2004; and claims benefit of foreign priority document EUROPEAN PATENT OFFICE (EPO) 03102296.5 filed on 7/25/2003; currently an English language translation of this foreign priority document has not been filed.

Accordingly, claims 22 and 29 are amended and 1-21, 28 and 32-42 are cancelled, no claims have been added.

Claims 22-24, 29 and 31 are currently under examination and are the subject of this Office Action.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



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Claim 22-24, 29 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are unclear whether the contacting step of contacting a plastic controls the metes and bounds of the claims or the preamble treatment of a surface of a plastic. For example a porous plastic may be internally contacted, such as during molding, with an antimicrobial without contacting what may be construed to be a surface of the plastic. Is the claim directed to treating a surface of a plastic or generally any aspect of the plastic without being limited as to surface contact?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

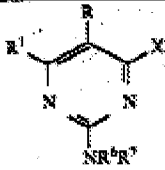

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).



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Claims 22-24, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunley et al. (US 4,116,674) and Ghosh (J. Indian Chem Soc, May 1983, pp. 512-513, provided by Applicant).

Sunley et al. teach the use of a similar compound to that elected by Applicant (please refer to Table 1, bridging columns 3-4):

TABLE I-continued					
					
COMPOUND NO	R <sup>1</sup>	R	X	-NR <sup>6</sup> R <sup>7</sup>	
48	CH <sub>3</sub>	CH <sub>3</sub>		NHCH <sub>3</sub>	80-81

Though the alkyl chain, on position NR<sub>6</sub>R<sub>7</sub> on the Table above is not the same chain length as the one provided by applicant (C<sub>8</sub>H<sub>18</sub>), the change of alkyl chain length is well within the purview of the skilled in the art, 84 USPQ 458 and 81 USPQ 383.

Further, 2,4-bis(arylamino)-6-methyl pyrimidines such as the elected compound, are well known for the effective treatment of antimicrobials (see page 512, column 1 and Table 3)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to administer the elected compound of Sunley et al., in view of the desirable results obtained and disclosed by Ghosh (see page 513, column 1), one of ordinary skill in the art would reasonably expect elected compound found in Sunley et al. to successfully promote an antimicrobial treatment. Such a modification would have been motivated by the reasonable expectation that a known 2,4-bis(arylamino)-6-methyl pyrimidine of would effective antimicrobial treatment. Further, it would be reasonable to expect that the elected compound would be equally effective in carrying out the therapeutic method of Ghosh.



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Concerning the claimed use on a plastic, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claims.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA PAGONAKIS whose telephone number is (571)270-3505. The examiner can normally be reached on Monday thru Thursday, 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AP

/Brian-Yong S Kwon/



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Primary Examiner, Art Unit 1614